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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/760,730	01/17/2001	Yoshihiro Masuda	108359	4837

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EXAMINER
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MEINECKE DIAZ, SUSANNA M

ART UNIT	PAPER NUMBER
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3623

DATE MAILED: 03/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.



**Office Action Summary**

Application No.

09/760,730

Applicant(s)

MASUDA ET AL.

Examiner

Susanna M. Diaz

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) 2,5 and 12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,6-11 and 13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 1/17/01.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.



### **DETAILED ACTION**

1. This Non-Final Office action is responsive to Applicant's election filed December 9, 2004.

Applicant elected Species II with traverse on the grounds that "the subject matter of all claims 1-13 is sufficiently related that a thorough search for the subject matter of any one species would encompass a search for the subject matter of the remaining claims." (Page 1 of Applicant's election) The Examiner respectfully disagrees. Even Applicant's own specification describes Species I and Species II as two separate (and mutually exclusive) embodiments since the control unit functions uniquely in each embodiment. See at least page 28 (last paragraph) of the specification. Therefore, the Examiner maintains that there would be undue burden in searching both species. Furthermore, it should be noted that Applicant has not asserted that Species I and Species II are not patentably distinct. Applicant's argument regarding the assertion that claims 3 and 4 should be generic claims is not persuasive. Claims 3 and 4 ultimately recite that the plural candidate execute elements are rearranged based on processing time. The discussion of this rearrangement is only found as part of the description of Species II (on pages 28-33) of the specification; therefore, the Examiner maintains that claims 3 and 4 are specific to Species II and not generic.

Claims 2, 5, and 12 stand as withdrawn.

Claims 1, 3, 4, 6-11, and 13 are presented for examination.



***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1, 3, 4, 6-11, and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 3, 4, 6-11, and 13 recite “executive elements.” What does “executive” signify in the scope of the present invention? “Executive” has many interpretations and Applicant’s intended interpretation is unclear. For examination purposes, an “executive element” will be interpreted as any part or element related to planning a project.

Claims 1, 3, 4, and 6 recite various “means” for performing different types of functionality; however, the specification does not utilize the term “means” to refer to any specific structural elements. Therefore, the scope of the various recited “means” is unclear. In other words, it is not clear whether these recited “means” refer to humans, software *per se*, software executed by hardware, hardware, or a combination thereof. For examination purposes, the recited “means” are interpreted as hardware or software executed by hardware. Please note that, if this is not Applicant’s assertion, a rejection of claims 1, 3, 4, and 6 under 35 U.S.C. § 101 may be raised in the future.

Claim 1 recites “managing them” in line 5. First, the scope of “managing” is not clear. Does it imply an active process of overseeing the usage of executive elements or processible tasks or can it merely refer to a more passive process, e.g., merely storing data regarding the item(s) to be managed? Second, does “them” refer to “executive



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elements” or “processable tasks”? For examination purposes, this occurrence of “them” will be interpreted as referring to “executive elements.” The same rejection applies to claims 6, 7, 9, 10, and 13 since they recite similar limitations.

In line 4 of claim 4, please clarify whether or not “them” refers to “plural candidate executive elements” or some other elements recited in the claim.

Claim 7 recites “analyzing, as instructed by the customer, tasks required for the specific service.” Is the instruction by the customer an express, or active, instruction of how the tasks should be analyzed or does it merely refer to an inherent, or passive, instruction that is understood based on the service requested by the customer? For examination purposes, the latter of the two will be interpreted.

The scope of “making” in line 2 of claim 8 is unclear. What is involved in “making the customer evaluate the result”? Is the customer somehow forced to evaluate the result or is the customer merely requested to give some sort of evaluation? For examination purposes, the latter of the two will be interpreted.

Claim 9 recites “selecting it” in line 7. Does “it” refer to “an executive element” or “each task”? For examination purposes, this occurrence of “it” will be interpreted as referring to “an executive element.”

Claims 10 and 11 appear to be directed toward a computer program product (i.e., an article of manufacture); however, the program is not expressly recited as being executable (e.g., when executed, causes a processor to perform...). Therefore, claims 10 and 11 improperly recite software *per se*.



The scope of the term "calls" in lines 1 and 3 of claim 11 is unclear. Typically, when one software module "calls" another, this means that the one software module invokes the other to execute. However, claim 11 recites that the various modules "call" an entity. Is this entity a software module, hardware, or a human? It seems awkward to refer to a software module or hardware as an entity *per se*. On the other hand, it is not understood how a software module would "call" a human.

Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 7-11 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory



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subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, while claims 7-9 recite a useful, concrete, and tangible result, they do not expressly incorporate technology. In other words, the recited steps may be carried out entirely by hand (i.e., by a human); therefore, claims 7-9 are deemed to be non-statutory.

Claims 10 and 11 recite software *per se*, which is non-statutory.

Appropriate correction is required.

*In light of the numerous rejections of the claims under 35 U.S.C. § 112, 2<sup>nd</sup> paragraph, the following art rejection reflects Examiner's best understanding of the claimed invention.*

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1, 3, 4, 6-11, and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by Stuart (U.S. Patent No. 6,466,935).



Stuart discloses an element organization support apparatus for selecting, for a project including plural tasks, executive elements for individual tasks and supporting organization of the plural executive elements, the apparatus comprising:

[Claim 1] executive element management means for classifying executive elements into processible tasks and managing them (Fig. 6; col. 4, lines 56-63; col. 6, lines 1-14);  
and

selecting means for selecting out of the executive element classification and management means a candidate executive element that can process each of the tasks (col. 6, lines 1-14, 22-45, 64-67);

[Claim 3] wherein the executive element management means includes a memory for storing at least element information that identifies a task processible by each executive element, and the selecting means selects, on the basis of the element information, a candidate executive element for processing each task required in a project (Fig. 6; col. 6, lines 1-14, 22-45; col. 7, lines 57-65);

[Claim 4] wherein the element information further includes data regarding processing time, and the selecting means, where there are plural candidate executive elements for a given task, rearranges them according to the processing time and presents the candidate executive elements (col. 6, lines 1-14; col. 11, lines 3-24).

Stuart discloses an element organization support apparatus for selecting, for use in the accomplishment of a job asking by a customer, an executive element for each of



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plural tasks involved in the job, and supporting organization of the plural executive elements to accomplish the job, comprising:

[Claim 6] executive element management means for classifying executive elements into processible tasks and managing them (Fig. 6; col. 4, lines 56-63; col. 6, lines 1-14); and

selecting means for selecting from the executive element management means a candidate executive element that can process each of the tasks (col. 6, lines 1-14, 22-45, 64-67).

Stuart discloses a service providing method comprising:

[Claim 7] classifying plural executive elements for executing tasks constituting in advance various services into processible tasks and managing them, each of the executive elements including at least one of human and physical elements (Fig. 6; col. 4, lines 56-63; col. 6, lines 1-14);

receiving a request for organizing, for the accomplishment of a specific service asked by a customer, executive elements for processing the specific service (Fig. 6; col. 4, lines 56-63; col. 6, lines 1-14);

analyzing, as instructed by the customer, tasks required for the specific service (Fig. 6; col. 4, lines 56-63; col. 6, lines 1-14); and

selecting from the executive elements classified and managed, on the basis of the result of the analysis, an executive element for executing the tasks (col. 6, lines 1-14, 22-45, 64-67);



[Claim 8] making the customer evaluate the result of the organization of the executive elements (col. 6, lines 11-14 -- Penalties and incentives are assessed based on an agreement with a customer. If the customer's needs are met, i.e., the customer is satisfied that the conditions of the agreement are met, the printer is given an incentive. Otherwise, if the customer's needs are not met, i.e., the customer is not satisfied that the conditions of the agreement are met, then penalties are assessed against the printer. This evaluation of whether or not conditions of the agreement have been met is effectively a customer evaluation of the organization); and

receiving, as the organizer of the executive elements, the evaluation and holding the evaluation in association with information concerning the organization of the executive elements provided to the customer (col. 6, lines 11-14 -- Penalties and incentives are assessed based on an agreement with a customer. If the customer's needs are met, i.e., the customer is satisfied that the conditions of the agreement are met, the printer is given an incentive. Otherwise, if the customer's needs are not met, i.e., the customer is not satisfied that the conditions of the agreement are met, then penalties are assessed against the printer. This evaluation of whether or not conditions of the agreement have been met is effectively a customer evaluation of the organization).

Stuart discloses an element organization support method for selecting, for a project including plural tasks, executive elements for individual tasks and supporting organization of the plural executive elements, the method comprising:



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[Claim 9] classifying the executive elements into processible tasks in advance and managing them (Fig. 6; col. 4, lines 56-63; col. 6, lines 1-14); and

searching the executive elements classified and managed for an executive element to execute each task and selecting it (col. 6, lines 1-14, 22-45, 64-67).

Stuart discloses a computer-readable storage medium storing thereon a program for selecting, for a project including plural tasks, executive elements for individual tasks and thereby supporting organization of the plural executive elements, the program comprising:

[Claim 10] a first module for classifying the executive elements into processible tasks in advance and managing them (Fig. 6; col. 4, lines 56-63; col. 6, lines 1-14); and

a second module for searching the executive elements classified and managed for an executive element to execute each task required for a given service and selecting it (col. 6, lines 1-14, 22-45, 64-67);

[Claim 11] wherein the first module calls an entity performing the classification and management of the executive elements, and the second module calls an entity searching for and selecting the executive element (col. 6, lines 1-14, 22-45, 64-67; col. 10, line 35 through col. 11, line 34).

Stuart discloses an element organization support system, comprising:

[Claim 13] a database server for classifying data pieces regarding plural executive elements for executing individual tasks constituting various services into processible



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tasks, and managing them, the data pieces regarding executive elements including at least one of human and physical elements (Fig. 6; col. 4, lines 56-63; col. 6, lines 1-14);

a reception server for receiving a request for preparation of organization of executive elements for processing a specific service asked by a customer (Fig. 6; col. 4, lines 56-63; col. 6, lines 1-14); and

an analysis server for analyzing tasks required for the specific service as instructed by the customer (Fig. 6; col. 4, lines 56-63; col. 6, lines 1-14), and selecting from the database server, on the basis of the result of the analysis, a data piece regarding an executive element for executing each of the tasks (col. 6, lines 1-14, 22-45, 64-67).

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Akifuji et al. (U.S. Patent No. 6,853,974) -- Discloses a system for monitoring the status of a workflow.

Leymann et al. (U.S. Patent No. 6,820,118) -- Discloses a system for alerting both human participants and software components if an error occurs in a workflow.

Lahey et al. (US 2003/0154115) -- Discloses a system for monitoring the status of a workflow.



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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna M. Diaz whose telephone number is (703) 305-1337. The examiner can normally be reached on Monday-Friday, 9 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (703) 305-9643. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

February 27, 2005

*Susanna Diaz*  
**SUSANNA M. DIAZ**  
**PRIMARY EXAMINER**  
*Au 3623*